

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Akitoshi KOJIMA et al.

Before the Board of Appeals

Application No.: 09/995,652

Confirmation No.: 2631

Filed: November 29, 2001

Art Unit: 3689

For: METHOD AND SYSTEM FOR
MERCHANDISE RETAIL MANAGEMENT
AND PORTABLE TERMINAL

Examiner: G. ARAQUE, JR.

REPLY BRIEF UNDER 37 C.F.R. § 41.41

MS APPEAL BRIEF - PATENTS

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief responds to the Examiner's Answer mailed September 23, 2009.

For clarity, the issues presented in the Appeal Brief filed December 8, 2008, will be repeated, and the reply to the Examiner's Answer will substantially correspond structurally to the argument section in the Appeal Brief.

I. GROUND S OF REJECTION TO BE REVIEWED ON APPEAL

The Final Office Action provides three (3) grounds of rejection for review on appeal.

- (1) Claim 14 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Trotta Jr. (USP 5,595,264) (hereinafter "Trotta");
- (2) Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Trotta in view of Garver (USP 7,114,656) (hereinafter "Garver"); and

(3) Claims 15-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Trotta in view of Garver and further in view of Murrah et al. (USP 5,804,807) (hereinafter "Murrah").

II. NEW POINTS OF ARGUMENT RAISED BY EXAMINER'S ANSWER:

Appellants are providing this Reply Brief to respond to new points of argument raised in the Examiner's Answer. Appellants do not disagree with paragraphs (1)-(2) and (4)-(8) of the Examiner's Answer.

The Examiner asserts in (3) Status of Claims that Appellants' statement of the status of the claims is incorrect. However, the Examiner does not provide any correct statement of the status of the claims. Appellants respectfully submit that the Statement of the Status of the claims as set forth in their submission on February 5, 2009 is correct.

The specific new points of argument that are raised in paragraph (10) to which Appellants disagree are as follows:

1. The Examiner, regarding claim 14, asserts that customer identifying information is nonfunctional descriptive subject matter and does not serve as a limitation on the claims to distinguish over the prior art. The Examiner further asserts that portable terminal, as purportedly disclosed in Trotta, is fully capable of reading information via radio waves from multiple wireless tags. Appellants' response to these assertions is discussed in paragraph A below.
2. The Examiner introduces new support for his rejection of claim 1 by relying on different combinations of devices and different combinations of the teachings of the cited art. Appellants' response to this assertion is discussed in paragraph B. below.
3. The Examiner introduces new support for his rejection of claim 3 by relying on his rejection of claim 14. Appellants' response to this assertion is discussed in paragraph C. below.

III. REPLY:

A. The Rejection Fails to Establish *Prima Facie* Anticipation of Independent Claim 14.

In response to the Appellants' arguments regarding claim 14, the Examiner responds in the Examiner's Answer on pages 11-12 as follows:

...the Examiner considers customer identifying information to be nonfunctional descriptive subject matter since it does not affect how the apparatus functions, communicates, or stores information. The type of data adds little, if anything to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish over the prior art. As claimed, the steps of the invention would be performed the same regardless of the type of data used. As a result, the Examiner asserts that the portable terminal as disclosed Trotta is fully capable of reading information via radio waves from multiple wireless tags.

Further still, a recitation of intended use of the claimed invention must result in a structural difference between the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Specifically, the Examiner asserts that the portable device as disclosed by Trotta is fully capable of wirelessly reading data stored onto a wireless tag, store the data read from the tag, transmit the data to an external apparatus (information processing apparatus) via radio waves, and display the read data. It is asserted that what the data describes does not affect how the portable device functions nor does it further limit and structure of the portable device. ...

Appellants disagree that these teachings are sufficient to teach or suggest "a tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remote from a checkout area and customer identifying information written onto another wireless tag; and a wireless communication device for transmitting commodity information to an information processing apparatus via radio waves at the same time that the commodity information is stored in the storage and transmitting the customer identifying information to the information processing apparatus via radio waves," as required by claim 14.

1. The cited art fails to teach or suggest "a tag reader for reading via radio waves ... information written onto a wireless tag," as recited in claim 14.

Claim 14 clearly requires a tag reader for reading via radio waves information written onto a wireless tag.

In support of his rejection, and in response to Appellants' arguments, the Examiner asserts that certain claim elements should not be afforded patentable weight as they are directed to non-functional descriptive material. Further, the Examiner asserts that "...the portable device as disclosed by Trotta is fully capable of wirelessly reading data stored onto a wireless tag, store the data read from the tag, transmit the data to an external apparatus (information processing apparatus) via radio waves, and display the read data. It is asserted that what the data describes does not affect how the portable device functions nor does it further limit and structure of the portable device."

However, throughout the disclosure of Trotta, the system described therein merely teaches an optical scanner having a bar code reading mechanism that transmits encoded bar code indicia information to a microprocessor. There is no disclosure in Trotta that is directed to a tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remote from a checkout area and customer identifying information written onto another wireless tag."

Further, an optical scanner is wholly insufficient to anticipate a tag reader for reading via radio waves information written onto a wireless tag.

Thus, even if the Examiner's assertions were, *arguendo*, true that customer identifying information is nonfunctional descriptive material, which Appellants do not admit, Trotta is still deficient as there is no teaching or suggestion in Trotta that is directed to a tag reader for reading via radio waves information from a wireless tag.

Thus, for at least this reason, Trotta fails to anticipate claim 14.

2. The cited art fails to teach or suggest "a tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remote from a checkout area and customer identifying information written onto another wireless tag;" as recited in claim 14.

In his Answer, the Examiner asserts that he "considers customer identifying information to be nonfunctional descriptive subject matter since it does not affect how the apparatus functions, communicates, or stores information. The type of data adds little, if anything to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish over the prior art. As

claimed, the steps of the invention would be performed the same regardless of the type of data used. As a result, the Examiner asserts that the portable terminal as disclosed Trotta is fully capable of reading information via radio waves from multiple wireless tags.”

Appellants disagree that customer identifying information is non-functional descriptive material.

As recognized in *Ex parte Nehls*, 88 USPQ.2d 1883 (BPAI 2008), the distinction between functional and nonfunctional descriptive material arose in the context of printed matter limitations. In determining patentability, differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. Under section 103, [one] ... cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must read a whole.” See *In re Gulak*, 703, F.2d 1381, 217 USPQ 401 (Fed Cir. 1983).

Printed matter that was functionally related to its substrate was held to distinguish the claimed product from the prior art. Although limitations reciting printed matter cannot be ignored, “[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.” The “critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.” *Id.* at 1386.

In support of his rejection, the Examiner admitted that the type of data adds to the claim’s structure. The recitation of the term “little” is of no consequence. Since the type of data adds to the claim’s structure, functionality is therefore imparted to the type of data. As such, patentable weight should be afforded to the claim term.

Further, the commodity information is information that is collected with the customer identifying information at the portable terminal. The portable terminal includes the tag reader for reading commodity information in an area remote from a checkout area, thereby enabling a shopper to use the portable terminal to read commodity information written on wireless tags. The commodity information that is read by the tag reader is stored thereby enabling a customer to shop and store the read commodity information. By reading the customer identifying information, and

transmitting the read commodity information and the customer identifying information to an information-processing apparatus, the customer may appreciate an improved shopping experience as discussed in the specification. As such, the customer identifying information is not merely printed matter that is non-functional descriptive matter. The customer identifying information, when considering the claim as a whole, and when read in light of the specification, does, in fact, impart functionality and structure on the claim.

Still further, the Examiner appears to be dissecting the claim, excising the printed matter from it, and declaring the remaining portion of the mutilated claim to be unpatentable. The Examiner, in support of his rejection, asserts “that the portable device as disclosed by Trotta is fully capable of wirelessly reading data stored onto a wireless tag, store the data read from the tag, transmit the data to an external apparatus (information processing apparatus) via radio waves, and display the read data.” The Examiner appears to be ignoring all of the claim elements that, in fact, impart structure and functionality in the claim, including **“a tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remote from a checkout area and customer identifying information written onto another wireless tag; and a wireless communication device for transmitting commodity information to an information processing apparatus via radio waves at the same time that the commodity information is stored in the storage and transmitting the customer identifying information to the information processing apparatus via radio waves.”** As such, the Examiner is not considering the claim as a whole and is not properly affording patentable weight to the claim terms.

Finally, the Examiner asserts that “a recitation of intended use of the claimed invention must result in a structural difference between the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.” However, Appellants respectfully submit that this language may be found in the MPEP §707.07, form paragraph No. 7.37.09, Unpersuasive Argument: Intended Use. Appellants argued in their Appeal Brief that the teachings of Trotta fail to anticipate the claim elements. Appellants did not present any arguments directed to intended use. As such, Appellants submit that this response is wholly non-responsive to the arguments set forth in Appellants’ Appeal Brief.

Trotta merely discloses a payment card being inserted into a scanner terminal in order to release a scanner to a customer. (see col. 3, lines 50-57). There is no disclosure that is directed to “a tag reader for **reading via radio waves** commodity information written onto a wireless tag located on a sample commodity remote from a checkout area and **customer identifying information written onto another wireless tag**; and a wireless communication device for transmitting commodity information to an information processing apparatus via radio waves at the same time that the commodity information is stored in the storage and **transmitting the customer identifying information** to the information processing apparatus via radio waves.”

For at least these reasons, it is respectfully submitted that the outstanding rejection is improper. In addition, for the reasons already of record, as more fully set forth in Appellants’ Appeal Brief, claim 14 is patentable over the art as cited.

B. The Rejection Fails to Establish *Prima Facie* Obviousness of Independent Claim 1.

In response to Appellants’ arguments regarding claim 1, the Examiner asserts on pages 13-14 as follows:

... However, as discussed in detail above, the information processing apparatus is the in-store computer that keeps the running total of the customer’s purchase [Col. 5 Lines 35-42] and receives the information as the customer is scanning the commodity and wherein the scanner terminal acts as the POS apparatus since it is the location where payment is finalized. The Examiner would like to clarify that the POS apparatus is meant to be the scanner terminal, i.e. base station, which the portable terminal is normally housed in and that the POS apparatus is not just the scanner terminal.

Trotta discloses that three pieces of equipment are in communication with one another in order to track/compare and complete the customer’s transaction. As discussed in Col. 5 Lines 35-42, Trotta discloses that the information processing apparatus, the portable terminal, and the base station, which retains the customer’s credit card, are in communication with one another and allows the customer to perform any desired transactions.

One of ordinary skill in the art would have recognized that the information that is scanned by the portable device is transmitted to the information processing apparatus in order to track the items that the customer desires to purchase, as well as to the base station, i.e. POS apparatus, in order to charge the credit card that is stored therein.

Further still, a comparison must be made since the file that is stored at the in-store computer must contain some type of identifier, which would identify the scanner with the customer, and when the scanner is placed back at the scanner terminal another type of identifier must then be transmitted from the scanner terminal to the in-store computer in order to compare that the two identifiers are the same in order to release the customer's payment card and the printing of the receipt of the total purchases. Moreover, such a comparison would also be necessary for the sole purpose of ensuring that the correct customer is being charged for the correct scanned items from the correct portable device at the correct base station....

... one of ordinary skill in the art looking upon Garver would have found it obvious to transmit information from a portable terminal to an information processing apparatus and a POS apparatus (self-checkout station; see at least Col. 6 Lines 2-8; figure 1A, Figure 1B #50 Portable Device, #40 POS apparatus, #31 information processing apparatus ...

Appellants disagree that the Examiner's new interpretation of the cited art is sufficient to teach or suggest "comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus," as required by claim 1.

The teachings of Trotta are clearly set forth in Appellants' Appeal Brief at least one pages 12-13. In response to Appellants' arguments regarding the deficiencies of the teachings of Trotta, the Examiner admits that the in-store computer maintains a running total of the customer's purchase and receives the information as the customer is scanning the commodity. Further, the Examiner asserts that "a comparison must be made since the file that is stored at the in-store computer must contain some type of identifier, which would identify the scanner with the customer, and when the scanner is placed back at the scanner terminal another type of identifier must then be transmitted from the scanner terminal to the in-store computer in order to compare that the two identifiers are the same in order to release the customer's payment card and the printing of the receipt of the total purchases."

However, claim 1 requires **comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus** at a sales counter and is then entered into the information-processing apparatus. The Examiner's

arguments appear to provide an argument for comparing **customer or scanner identifying information**. However, Appellants respectfully submit that interpreting **commodity information** to mean customer identifying information, or a terminal identifier, is an unduly broad interpretation of the claim term. Claim 1 clearly requires **comparing at the information-processing apparatus the commodity information** which has already been relayed to the information-processing apparatus, **with commodity information** which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus.

Still further, since the Examiner admits that Trotta discloses the in-store computer receiving the information as the customer is scanning the commodity, there would be no reason to modify Trotta in order to make such a comparison.

As Garver fails to cure the deficiencies of the teachings of Trotta, Appellants respectfully submit that, for at least these reasons, claim 1 is patentable over the references as cited.

Further, for the reasons already of record, as more fully set forth in Appellants' Appeal Brief, claim 1 is patentable over the art as cited.

C. The Rejection Fails to Establish *Prima Facie* Obviousness of Independent Claim 3.

In response to Appellants' arguments regarding claim 3, the Examiner asserts on page 15 as follows:

... Additionally, the Examiner notes that claim 3 is directed towards a system. In other words, the Examiner asserts that the claim is directed towards apparatuses in communication with one another and capable of transmitting and receiving data. Therefore, the Examiner asserts that the rejection is also maintained for the reasons stated for claim 14 above since the type of data that is being scanned, transmitted, and received is considered to be non-functional descriptive subject matter and that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is asserted that the prior art is, indeed, capable of performing the processes as set forth in claim 3.

Appellants disagree with the Examiner's assertions.

In their Appeal Brief, Appellants argued that the cited references failed to teach or suggest all of the claim elements including “an information-processing apparatus for receiving the relay from the portable terminal, indicating what commodity to have prepared in accordance to what the customer has indicated the intent to purchase and comparing the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to the POS apparatus and is then entered into the information-processing apparatus,” as required by claim 3. None of the Examiner’s comments address this argument. As such, for the reasons set forth more fully in Appellants’ Appeal Brief, Appellants maintain that claim 3 is patentable over the references as cited.

IV. CONCLUSION

For all the reasons set forth above, the rejections set forth in the Examiner’s Answer dated September 23, 2009, are improper. It is therefore respectfully requested that the Examiner be reversed on all grounds.

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Respectfully submitted,

By 

Catherine M. Voisinet
Registration No.: 52,327
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Appellants